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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Guerry L. Grune

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EXAMINER

MIZRAHI, DIANE D

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

04/07/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/896,238	<b>Applicant(s)</b> GRUNE ET AL.	
	<b>Examiner</b> DIANE MIZRAHI	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

This action is responsive to the Request for Continued Examination Under 37 CFR 1.114 and Amendment filed January 3, 2011. Claims 23-33 are pending in this Application. Applicant has canceled claims 1-22.

### ***Request for Continued Examination Under 37 CFR 1.114***

This is in response to request for amendments filed January 3, 2011, Continued Examination Under 37 CFR 1.114.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission and its accompanying amendment filed on January 3, 2011, has been entered.

### ***Specification***

The specification is objected to for failing to provide proper antecedent basis for the claimed subject matter of Claims 23-33. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Claims 23-33 of the originally filed specification recites, **“computer readable medium” and “client-server engine system”**. There is no mention of and **“computer readable medium and “client-server engine system”** in the original specification. Appropriate correction is required.

### ***Claim Objections***

Claims 23-33 are objected to because of the following informalities:

In regards to Claims 23-33:

Claims 23-33 recite the limitations: "wherein"; "whereby" and "configured to".

MPEP 2106 (II C) states "the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language *that suggests ..... or makes optional* but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim language. The following examples of language that may raise a question as to limiting effect of the language in a claim:

- A. statements of intended use of field or use,
- B. "adapted to" or "adapted for" clauses,
- C. "wherein" clauses,
- D. "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP 2111.04."

Since "wherein", "whereby" and "configured to" suggests or make optional the

Art Unit: 2617

limitations following the claim language, Applicant is hereby advised that these limitations may not be given weight in future office actions.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *id.* However, the court noted (quoting *Minton v. Nat 'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited," *Id.* See MPEP 211 t.03 17.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 23-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

Art Unit: 2617

which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant recites in the claims the claimed, **“computer readable medium”** and **“client-server engine system”**. Further clarification is required.

2. Also, in regards to claims 23-33 Applicant claims "computer readable medium ....system.... said method requiring at least the following steps". Examiner is unclear as to which is Applicant claiming? Are these claims a computer readable medium, system or method? Also, Claim 31 claims "computer readable medium... method.. step of ". Claims 32-33, recite, "computer readable medium.... client server engine system... the sequential steps of". Similarly, what type of claims are these, computer readable medium, system or method? Correction is required.

3. Claims 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant recites in the claims the claimed, **“computer readable medium”** and **“client-server engine system”**. Further clarification is required.

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-30 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to what the Applicant means by the claimed, "itself". Examiner believes that the metes and bounds of the claims are ambiguous; rendering the claims not clear and indefinite. Applicant has not particularly pointed out the subject matter, **"itself" (Claim 24) and "they" (Claim 31)**. Further clarification is required.

5. In regards to Claims 23-33, Examiner is unclear as to what are "evaluation methods". Are valuation methods comprising of Black-Sholes pricing theory, Technology Risk/Reward Unit and Discounted Cash Flow models? Further clarification is required in the claims.

6. In regards to Claim 26, Examiner is unclear as to what Applicant means by the claimed, "a combination". What is a combination? What are the elements that make up the combination? Further clarification is required.

7. Claims 23-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner is unclear as to what is meant by the following claimed limitations:

- (1) "optionally" (Claim 23);
- (2) "simultaneous... . determination... manner ... valuation ... matching...",

- etc. Claims 24-29);
- (3) "instantaneous fashion" (Claim 17);
  - (4) " simultaneous, instantaneous or simultaneous and instantaneous"  
(Claim 31).
  - (4) "meaningful manner" (Claims 31-33);
  - (5) "instant valuation: (Claim 31).

8. Claim 23 recites the limitation " said method". There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation " one of the valuation methods". There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation "based on the number of valuation methods". There is insufficient antecedent basis for this limitation in the claim.

9. Claims 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner is unclear as to how the claimed, "generating an electronic shoe" occurs. It appears there is a missing step. There appears to be no particular transformation of data. Is Applicant generating a contour map using search results from patent and non-patent literature using valuation methods that could comprise of Black-Sholes pricing theory, Technology Risk/Reward Unit and Discounted Cash Flow models by superimposing normalized values on the contour map with valuation trends and statistics which indicate shifts in technology trends? Appropriate action is required.

Examiner has made every attempt to locate other potential problems under 35 USC 112. Examiner requests that the Applicant review the claims and correct the all the claims.

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-33 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

A § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter.

As to claims 31-33 these claims recited purely mental steps. These claims lack the necessary physical articles or objects to constitute a machine or a manufacture

Art Unit: 2617

within the meaning of 35 USC 101. As such, they fail to tie with a statutory category. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claims 31-33 are rejected as falling under the judicial exception of an abstract idea which lacks a useful, concrete, and tangible result. A claimed series of steps or acts for which there does not appear to be disclosed a result in a useful, concrete, and tangible result are not statutory within the meaning of 35 USC 101.

In the instant case, the claims recite, “\_\_[enabling]\_,” “\_\_[providing]\_,” “\_\_[performing]\_,” and “\_\_[allowing]\_.”

However, no useful, concrete, and tangible result is disclosed in the instant application as originally filed. For example, “writing said data,” “updating said data,” “transforming said data” being claimed at the end of the claim may comprise a useful, concrete, and tangible result. Absent such a disclosed result, however, the claims are not statutory.

***Allowable Subject Matter***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure [see USPTO 892]:

Claims 23-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 112, 1<sup>st</sup> and 2nd paragraphs and objections, as noted above, set forth in this Office action.

The following is an examiner's statement of reasons for allowance:

Interpreting the claims in light of the specification, Examiner finds the claimed invention is patentably distinct from the prior art of record, which sets forth in the following: the prior art of record does not teach the combination of claimed elements including and under the broadest reasonable interpretation of the claimed limitation consistence with the Applicant's Specification. The prior art cited above fails to teach all of the Applicant's claimed limitation. In particularly, the claimed invention advantageously provides a finer level of detail that includes searching databases containing patent, non-patent, publication databases, and problem solving databases, using the results from the documents retrieved from these databases for accessing a valuation database in which valuation methods for valuing data, such as Black-Sholes pricing theory, Technology Risk/Reward Unit and Discounted Cash Flow models and

Art Unit: 2617

other models , are used along with other knowledge based databases, superimposing normalized values based on numerous valuation methods on a contour map with valuation trends and statistics which indicate shifts in technology trends, and generating a report based on user selections in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record in context to the claims and the specification.

The Examiner asserts that the claims overcome the prior art of record as describes above when the limitations are read in combination with the respective claimed limitations in their entirety.

Thus, prior art of record neither render obvious nor anticipates the combination of claimed elements in light of the specification.

It is noted, *PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN* "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments (see MPEP 2123).

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. (See MPEP 2123.)

The prior art not relied upon but considered pertinent to applicant's disclosure is made of record and listed on form PTO-892.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday (9:30 - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communication.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Diane Mizrahi/

*Diane.Mizrahi@USPTO.gov*  
Primary Patent Examiner

April 3, 2011